

U.S. Patent Appln. No. 10/600,280
Amendment Dated June 29, 2005
Reply to Office Action of Jan. 3, 2005
Docket No. 7505-1

REMARKS/ARGUMENTS

These remarks are submitted responsive to the office action dated January 3, 2005 (Office Action). This response is filed after the 3-month shortened statutory period, and as such, a retroactive extension of time is herein requested. The Examiner is authorized to charge the appropriate extension fee to Deposit Account 50-0951.

The Examiner has rejected Claims 5, 8-9 and 11 under 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the invention. The Examiner states that the claims are vague and indefinite because they recite "said decontamination device" within the body of the claims, thereby improperly attempting to define the invention by itself. With respect to claims 5 and 8, decontamination device(s) have been amended and replaced by housing(s). With respect to claims 9 and 11, the Examiner's position is not understood. In the body of claim 9, it states "wherein said housing comprises indicia providing information concerning said decontamination device." Accordingly, "said decontamination device is not positively recited but is merely set forth to explain the indicia providing information."

A similar issue is present in claim 11 which states "wherein said indicia comprises at least one selected from the group consisting of the contaminating compound and the medical apparatus for which the contaminated device is intended." Once again, the decontamination device is not positively recited but only set forth to explain "the medical

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apparatus." As such, the use of "decontamination device" is permissible and is not indefinite under 35 U.S.C. § 112.

In the Office Action, the Examining Attorney has rejected claims 1-3, 14, 19, 21 and 22-23 under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 5,641,464 to Briggs, III *et al.* (Briggs). Briggs discloses:

"A device with a chamber 13 into which the head of a stethoscope can be placed and then sprayed with a disinfectant from canister 15. The stethoscope head 27 of stethoscope 58 is placed through a diaphragm 60 so that when the head 27 is inserted into chamber 13 diaphragm 60 closes around tube 28 of the stethoscope 58 ceiling plate 40 from egress of aerosol spray from canister 15."

The Briggs reference is fundamentally different from Applicants' invention and does not anticipate Applicants' claims although Applicants have amended their claims to better distinguish over the Briggs reference. No new matter has been added.

Claim 1 has been amended to point out the use of an absorbent pad carrying a decontaminating compound as distinguished from a spray canister such as used in Briggs. In Applicants' device, the housing holds the absorbent pad within its structure and positively engages the absorbent pad against a portion of the medical apparatus (stethoscope head) whereby the absorbent pad is placed into direct contact with the

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portion of said medical apparatus; then removed from contact upon disengagement. Thus, the housing has structure associated therewith so the stethoscope head is forced into contact with the absorbent pad and then of course released as the stethoscope head is withdrawn from the housing upon disengagement.

Thus, Briggs lacks an absorbent pad carrying a decontaminating compound as well as structure for removably engaging said housing with respect to a portion of said medical apparatus whereby said absorbent pad is placed into contact with said portion of said medical apparatus upon engagement and removed from contact upon disengagement.

Claim 2 calls for interlocking structure for engaging a portion of said medical apparatus which is completely absent from Briggs.

Claim 3 goes on to define interlocking structure as one elastically deformable, inwardly directed protrusion on said housing. Once again, such structure is completely lacking in Briggs.

Claim 14 calls for a decontaminating compound selected from the group consisting of chlorine compounds but is not met by Briggs because of the amendments to claim 1 from which claim 14 depends. The same holds true for claims 19 and 21.

With respect to claims 22 and 23, claim 22 has been amended to clearly demonstrate that the decontamination device is engaged with said medical apparatus during both the decontamination step and the medical use step. This points out one of the

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significant advantages of Applicants' device which is that when connected by the lanyard to stethoscope tubing, the decontamination device can hang from the stethoscope tubing and be ready for use between patients with the stethoscope not having to be removed from the doctor's body. For example, the stethoscope tubing to the ear pieces can be placed around the doctor's neck between patients as is customarily done with Applicants' decontamination device engaged with the stethoscope head during the decontamination step.

Nothing like this is contemplated by Briggs. In fact, it is contemplated that the stethoscope be removed from the doctor as the stethoscope head is placed into the Briggs chamber. No mention is made of disinfecting the stethoscope head while being carried around the neck of a doctor.

Claims 1-23 have also been rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Patent No. 5,722,537 to Sigler (Sigler) in view of Briggs. Sigler discloses a portable disinfecting container for an infant's pacifier. As such, it is non-analogous art and should not have been cited in the first instance (MPEP 2141.01(a)). To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art:

The Examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the

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reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). *See also* In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); and Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993).

Further, the Examiner has misunderstood an important aspect of Sigler assuming *arguendo* that the reference is citable. In particular, the Examiner states speaking of Sigler "The device is provided with hook or lanyard means to connect it to the Pacitizer even when not in use." Sigler, in describing Fig. 1, states "spring-biased fastener 4 when it is desired to attach The Pacitizer 1 to a purse, baby bag, stroller, crib etc." The Pacitizer is the portable disinfectant container. Further, when speaking about Fig. 3 where the biased hook 4 is replaced with an eyelet-type fastener 12 contemplating straps 14, it is contemplated that the straps will be attached to a crib rail, stroller handle or other large article. There is no mention that the hook 4 or straps 14 will be connected to the pacifier

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itself. Accordingly, there is no teaching for attaching a lanyard from Applicants' decontamination device to the medical apparatus (stethoscope) itself. As the pacifier is roughly equivalent to the stethoscope in Applicants' claims, (these are the two items to be disinfected), the use of Sigler as a reference breaks down. This also helps to understand why the reference should be considered non-analogous to begin with.

Further there is nothing in either Sigler or Briggs that would give the slightest hint of any lawful combination between the two references. Just as the Sigler reference is an inappropriate citation, the error is compounded as the combination of the two references makes no sense whatsoever and should be withdrawn.

Sigler offers nothing in addition to Briggs for a rejection of claim 1 as it does not further any of the structure of claim 1. In neither Sigler nor Briggs is there any hint of positively engaging an absorbent pad up against the head of a stethoscope by engagement structure associated with the housing of the absorbent pad. The references fail singularly, or in combination, to hint at the inventive direction of Applicants' invention. The closest effect that Sigler could have would be with respect to Applicants' claims 5 and 6, *i.e.*, the additional means for attaching which is then subsequently described as a lanyard. Such application however is dependent upon the Examiner misreading the Sigler specification. As pointed out above, the attachment means of Sigler 4, 14 is for attaching the

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decontamination device to some other physical article and not the object to be disinfected, *i.e.*, Applicants' medical apparatus, *i.e.*, stethoscope.

Also, claim 21 helps to point out a clear patentable feature over the two references. Claim 21 claims the decontamination device of claim 1 wherein said housing is dimensioned to receive the head of a stethoscope. Combined with the removable engagement and disengagement language of claim 1, claim 21 points out the need for a positive engagement of the stethoscope head within the housing to force it into engagement with the absorbent pad. The Briggs and Sigler patents would have no interest in the precise size of the stethoscope head or the size of the pacifier as long as the containers were big enough to hold such objects. This is because in neither case is the positive engaging nor disengaging structure important to be fitted with the stethoscope head so that a proper engagement occurs to assure decontamination. Rather, in Briggs and Sigler it is just a case of placing the items to be decontaminated, loosely in the decontamination containers.

Finally, the method of claim 22 is clearly distinguishable over any possible combination of Briggs and Sigler. Neither reference suggests a decontamination device that is connectable to the apparatus to be decontaminated during both steps of use of the apparatus and of the decontamination apparatus.

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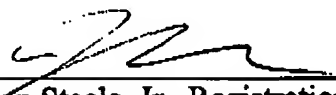
As pointed out above, this is a foreign concept to Briggs. In the case of Sigler, it would be tantamount to connecting the disinfectant structure to the pacifier as the baby was using the pacifier and subsequently sticking the pacifier into the decontamination device with the baby somehow wearing the decontamination device.

Applicants' attorneys are very disappointed in the inability to have a meaningful interview either by telephone or in person. It is now hoped that this application will receive the attention it deserves.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. A courtesy copy of this response is being sent to Examiner Kim, as discussed.

Respectfully submitted,

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